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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,270	01/17/2002	Robert Nissels	14313	1300
25763	7590	08/20/2004	EXAMINER	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498				SIRMONS, KEVIN C
		ART UNIT		PAPER NUMBER
		3763		

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/053,270	NISSELS, ROBERT
	Examiner	Art Unit
	Kevin C. Sirmons	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 18-28 is/are pending in the application.
 - 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 18-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant functionally recites “wherein abutting the suction chamber against the tissue of the patient causes the cut-off valve to open, which places the suction chamber and volume in fluid communication, thereby causing a state of reduced pressure within the suction chamber and bringing the tissue in contact with the dispensing means.” It is unclear to the examiner how this function is performed. What enables the cut-off valve to open? Is it a sensor or a mechanical mechanism, which allows for the cut-off valve to open?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the structural element(s) that causes the cut-off valve to open by abutting the suction chamber against the skin.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagner U.S. Pat. No. 4,284,077.

Wagner discloses a device comprising a casing a suction chamber connected to the casing, a piston pump, a passage interconnecting the suction chamber to the volume, and a cutoff valve (see fig. 1 and entire reference).

Response to Arguments

Applicant's arguments filed 4/27/04 have been fully considered but they are not persuasive.

In response to applicant's argument that the device is configured such that "abutting the suction chamber against the tissue of the patients causes the cut-off valve to open, which places the suction chamber and volume in the fluid communication, thereby causing a state of reduced

pressure within the suction chamber and bringing the tissue in contact with the dispensing means” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The previous examiner has already addressed applicant arguments in reference to the functional language. Therefore, the current examiner will not address previously addressed arguments, which the current examiner absolutely supports.

As to independent claim 18, it is the examiner position that in order for the valve of Wagner to work properly the suction chamber has to abut against the tissue of the patient and the knob activated causing the cut-off valve to open. The valve would not work properly if the suction chamber were not abutting the tissue. Therefore, the abutting of the suction chamber against the tissue is part of the reason why the valve opens. Applicant has not excluded an additional step of actuating the control valve by hand. Furthermore, applicant disclosure (page 7) clearly indicates that the valve is opened by manually. Therefore, it is the examiner’s position that the device as claimed by applicant and the device as taught by Wagner are structurally equivalent. Additionally, the structure of Wagner is capable of performing the function as set forth in the claims.

Finally, applicant has not claimed “a piston pump” for creating a state of reduced pressure within the suction chamber and bringing the tissue in contact with the dispensing

means. Applicant merely claims, "the piston within the cylinder to create a volume within the cylinder having a state of reduced pressure and the lock is adapted to lock the piston in place to maintain the state of reduced pressure."

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

Kevin C. Sirmons

Kevin C. Sirmons
Patent Examiner
8/18/04